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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/864,761	05/23/2001	Sharron Gaynor Penn	AEOMICA_X_1	6802

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FISH & NEAVE  
1251 AVENUE OF THE AMERICAS  
50TH FLOOR  
NEW YORK, NY 10020-1105

EXAMINER

LY, CHEYNE D

ART UNIT

PAPER NUMBER

1631

DATE MAILED: 02/06/2003

12

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/864,761

Applicant(s)

PENN ET AL.

Examiner

Cheyne D Ly

Art Unit

1631

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 05 December 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 59-130 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 59-130 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

1. Applicants' response, Paper No. 11, filed December 05, 2002, to Restriction Office Action, Paper No. 10, mailed October 30, 2002, is acknowledged.
2. It is acknowledged that claims 1-58 have been cancelled.
3. This Restriction Office Action was necessitated by the introduction of new claims 59-110, Paper No. 11, filed December 05, 2002.

***Election/Restrictions***

4. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 59-78, drawn to a method of selling and/or licensing single-exon microarrays to at customer, classified in class 705, subclass 1. If this Group is elected, then the below summarized sequence election is required. If this Group is elected, then the below summarized specie election is also required. Also, if this Group is elected, then the below summarized specie election is also required.
  - II. Claims 79-93, drawn to a method of selling and/or licensing single exon probes to a customer, classified in class 705, subclass 1. If this Group is elected, then the below summarized sequence election is required. If this Group is elected, then the below summarized specie election is also required. Also, if this Group is elected, then the below summarized specie election is also required.
  - III. Claims 94-109, drawn to a method of providing human gene expression data by subscription, classified in class 705, subclass 1. If this Group is elected, then the below summarized sequence election is required. If this Group is elected, then

the below summarized specie election is also required. Also, if this Group is elected, then the below summarized specie election is also required.

- IV. Claims 110-130, drawn to a method of manufacturing a microarray that has single exon probes that share at least one customer-identified attribute in common, classified in class 29, subclass 592. If this Group is elected, then the below summarized sequence election is required. If this Group is elected, then the below summarized specie election is also required. Also, if this Group is elected, then the below summarized specie election is also required.

**Sequence Election Requirement Applicable to All Groups:**

In addition, each Group detailed above reads on patentably distinct sequences. Each sequence is patentably distinct because they are unrelated sequences, and a further restriction is applied to each Group. For an elected Group drawn to amino acid/polypeptide sequence, the Applicants must further elect a single amino acid/polypeptide sequence. For an elected Group drawn to nucleotide sequences, the Applicants must elect a single nucleic sequence (See MPEP § 803.04). Specific to Group I, the claims in these Groups are directed to a combination which is at least a plurality of nucleic acid sequences. Applicant may elect two sequences if Group I is elected. It is noted that specific sequences are present in Tables 4-13. It is noted that the multiple of sequence submissions for examination has resulted in an undue search burden if more than one nucleic acid sequence is elected, thus making the previous waiver for up to 10 elected nucleic sequences effectively impossible to reasonably implement.

MPEP § 803.04 states:

Nucleotides sequences encoding different proteins are structurally distinct chemical compounds and are unrelated to one another. These sequences are thus deemed to normally constitute independent and distinct inventions with the meaning of 35 U.S.C. 121. Absent evidence to the contrary, each such nucleotide sequence is presumed to represent an independent and distinct invention, subject to a restriction requirement pursuant to 35 U.S.C. 121 and 37 CFR 1.141 et seq. Examination will be restricted to only the elected sequence. It is additionally noted that this sequence election requirement is a restriction and not a specie election requirement.

**SPECIE ELECTION REQUIREMENT FOR GROUPS I-IV:**

2. This application contains claims directed to the following patentably distinct species of the claimed invention:

Species A: lack prokaryotic and bacteriophage vector sequence.

Species B: lack homopolymeric stretches of A or T.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 59-64 and 69-78 Group I; claims 79-81 and 84-93 of Group II; claims 94-96 and 99-109 of Group III; and claims 110-115 and 120-130 of Group IV are generic. Species A and B are distinct because they are generally separately analyzed and published, and thus document the undue search burden if searched together.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

**SPECIE ELECTION REQUIREMENT FOR GROUPS I-IV:**

2. This application contains claims directed to the following patentably distinct species of the claimed invention:

Species A: Product is offered for sale.

Species B: Product is offered for licensing.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 59-85 of Group I; claims 79-91 of Group II; claims 94-107 of Group III; and claims 110-1128 of Group IV are generic. Species A and B are distinct because they are distinct type of transactions. These types of transactions are generally separately published, and thus document the undue search burden if searched together.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

5. The inventions of Groups I-IV are distinct inventions because they are directed to distinct methods regarding the critical limitations therein. Group I is directed toward a method of selling and/or licensing single-exon microarrays to at customer. Group II is directed toward a method of selling and/or licensing single exon probes to a customer. Group III is directed toward a method of providing human gene expression data by subscription. Group IV is directed toward a method of manufacturing a microarray that has single exon probes that share at least one customer-identified attribute in common. It is acknowledged that the commonality of these

Art Unit: 1631

groups is the transaction of providing either microarray related products or data to a customer.

However, the completely distinct critical limitations of each Group of the inventions support the undue search burden if they were examined together. For example, the limitation of providing a single exon microarray of Group I causes Group I to be distinct from Group II because Group II has the critical limitation of provide a single exon probe to a customer. For Group III, the differentiating limitation is human gene expression data. For Group IV, the differentiating limitation is a manufacturing process according to a customer set of parameters. Additionally, these methods with their critical limitations have been most commonly, albeit not always, separately characterized and published in the Biochemical literature, thus significantly adding to the search burden if examined together as compared to being search separately.

6. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

7. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

8. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).



Art Unit: 1631

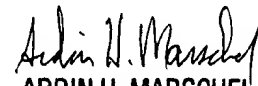
9. Papers related to this application may be submitted to Technical Center 1600 by facsimile transmission. Papers should be faxed to Technical Center 1600 via the PTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform with the notices published in the Official Gazette, 1096 OG 30 (November 15, 1988), 1156 OG 61 (November 16, 1993), and 1157 OG 94 (December 28, 1993) (see 37 CFR § 1.6(d)). The CM1 Fax Center number is either (703) 308-4242 or (703) 305-3014.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to C. Dune Ly, whose telephone number is (703) 308-3880. The examiner can normally be reached on Monday-Friday from 8 A.M. to 4 P.M.

11. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward, Ph.D., can be reached on (703) 308-4028.

12. Any inquiry of a general nature or relating to the status of this application should be directed to Legal Instruments Examiner, Tina Plunkett, whose telephone number is (703) 305-3524 or to the Technical Center receptionist whose telephone number is (703) 308-0196.

C. Dune Ly  
2/5/03

  
ARDIN H. MARSCHEL  
PRIMARY EXAMINER